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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/901,400	07/09/01	WORMSBAECHER	G-00262C1

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EXAMINER

KIM, H

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 10/23/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/901,400

Applicant(s)
Wormsbaecher

Examiner
Harry C. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 9, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Claim Objections

Claim 5 is objected to because “**slip** joint connection assembly of claim 4” should be corrected to “**universal** joint connection assembly of claim 4”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 6-14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the term “the axis of rotation” of line 2 lacks proper antecedent basis.

Regarding claim 6, the phrase “plurality of **axially** extending **semi-circular** openings” of line 8 is inconsistent with the previously recited “plurality of circumferentially distributed, **longitudinally** extending, axis-parallel openings”. Further, the term “the splined shaft coupling” of line 9 lacks proper antecedent basis.

Regarding claim 9, the phrase “the plurality of **axially** extending C-shaped recesses” of line 11 is inconsistent with the previously recited “circumferentially distributed, **longitudinally** extending, axis-parallel, C-shaped recesses”.

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Regarding claim 12, the term "the transfer case" of line 3 lacks proper antecedent basis.

Regarding claim 13, the phrase "plurality of axis-parallel **openings**" of line 12 is inconsistent with the previously recited "plurality of radially equispaced, longitudinally extending, axis-parallel **recesses**".

The preceding list is not intended to be a comprehensive recitation of the informalities. Applicant is urged to carefully review and make appropriate corrections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishibashi et al. in view of Bush.

Ishibashi et al. discloses the claimed structural limitations of a splined connection assembly (see **Figs. 14-16**) comprising a splined shaft 16 having a plurality of male splines 15 formed thereon, a receiving member 14a having a plurality of mating female splines 13 formed thereon, and a plurality of radially equispaced, axially extending, two-part elongate members 28 for providing a radial force to compensate clearance deviations between the mating male and female splines.

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Further, the receiving member 14a is provided with a plurality of corresponding wider openings 13a for accommodating the two-part elongate members 28 therein. However, Ishibashi et al. fails to show the elongate members 28 being C-shaped or tubular with the receiving member 14a having a plurality of corresponding openings thereon to retain the C-shaped or tubular elongate members.

Bush teaches a similar connection assembly between a receiving member 50 having a plurality of axially extending C-shaped openings 64 thereon and a mating shaft member 38 wherein a plurality of radially equispaced, axially extending, one-piece, C-shaped or tubular, elongate members 32 is disposed in the axially extending openings 64 of the receiving member to provide a radial force for compensating clearance deviations between the mating members.

Therefore, as taught by Bush, it would have been well within the purview and obvious to one of ordinary skill in the art at the time the invention was made to facilitate assembly and to enhance the overall cost-effectiveness of the splined connection assembly of Ishibashi et al. by substituting the two-piece elongate members and the corresponding openings in the receiving member with the simpler and easier to use one-piece, C-shaped or tubular, elongate members and the corresponding openings in the receiving member to effectively compensate clearance deviations between the mating members.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment

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by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,257,798. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applicant is merely presenting claims which are broader than the claims of the U.S. Patent No. '798 by omitting certain limitations, e.g. the tubular members being received in a plurality of "circumferentially distributed, longitudinally extending axis parallel" openings. Therefore, claims 1-14 of the instant application are considered unpatentable under the doctrine of obviousness-type double patenting.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Moorhouse, Seibert, Geisthoff, Gilman, Beckman et al., Stickan, and Knodle et al. show similar connection assemblies.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Harry C. Kim whose telephone number is (703) 308-2248. The examiner can normally be reached on Mon.-Fri. from 6:00 AM to 3:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne, can be reached on (703) 308-1159. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

HCK
October 16, 2001


HARRY C. KIM
PRIMARY EXAMINER
TECH CENTER 3600